

Appln. No. 10/789,713
Amendment dated February 23, 2005
Reply to Office Action mailed November 23, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 3, 5 through 8 and 10 through 16 remain in this application. Claims 4 and 9 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The drawings have been objected to.

The claims have been amended to remove claimed matter that is not shown in the drawings.

In light of the proposed amendment, it is therefore submitted that the objection to the drawings as originally filed has been overcome, and withdrawal of the objection to the drawings is respectfully requested.

Paragraph 2 of the Office Action

The specification has been objected to for the informalities noted in the Office Action.

The specification has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

Paragraphs 3 and 4 of the Office Action

Claims 6, 10 and 13 have been rejected under 35 U.S.C. §112 (first paragraph) as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

The specification has been amended in a manner believed to enable one skilled to make/or use that describe in the claims, particularly at the points

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identified in the Office Action.

Withdrawal of the §112 (first paragraph) rejection of claims 6, 10 and 13 is respectfully requested.

Paragraphs 5 and 6 of the Office Action

Claims 6, 10 and 13 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The specification has been amended in a manner believed to enable one skilled to make/or use that describe in the claims, particularly at the points identified in the Office Action.

Withdrawal of the §112 rejection of claims 6, 10 and 13 is therefore respectfully requested.

Paragraphs 7-9 of the Office Action

Claims 1, 2, 4, 6, 7-9, 11 and 13-15 have been rejected under 35 U.S.C. §102(b) as being anticipated by Smart (US 4,825,475).

In regard to claims 1 and 11, it is submitted that the Smart reference does not disclose, teach or suggest "a pocket positioned on an interior surface of said flexible band, said pocket selectively retaining a user accessory, said pocket having an open side for permitting insertion of the user accessory in said pocket through said open side, said open side of said pocket being positioned in spaced relationship from an edge of said flexible band to inhibit access to said pocket when said flexible band is being worn by the user, said pocket being visually obscured by said flexible band". The Smart reference teaches a pantleg restraining band that fails to teach pocket being positioned on an interior surface of the flexible to receive the a user accessory with the open side of the pocket being positioned in a spaced relationship to the edge of the flexible band as claimed by the applicant. Further, the Smart reference teaches a clip being inserted into an inverted pocket to clip a portion of the pocket and a portion of the pantleg within the clip to secure the band to the pant legs and therefore the clip is not an

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accessory but a requirement of the application and additionally the inverted pocket would be ineffective at retaining articles as the articles would tend to slide out of the pocket being that it is inverted and therefore the Smart reference fails to meet the requirements of the applicant's claims. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Smart reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 2, 6, 7 and 8 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 6, 7 and 8 are also believed to be allowable over the cited reference.

Claims 13 through 15 are dependent upon claim 11, particularly as amended, and therefore incorporates the requirements of claim 11. Thus, claims 13 through 15 are also believed to be allowable over the cited reference.

Claims 4 and 9 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1, 2, 4, 6, 7-9, 11 and

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13-15 is therefore respectfully requested.

Paragraphs 10 and 11 of the Office Action

Claims 1-5, 7-9, 11, 12 and 14 have been rejected under 35 U.S.C. §102(b) as being anticipated by Tomlinson et al (US 5,749,769).

In regard to claims 1 and 11, it is submitted that the Tomlinson reference does not disclose, teach or suggest "a pocket positioned on an interior surface of said flexible band, said pocket selectively retaining a user accessory, said pocket having an open side for permitting insertion of the user accessory in said pocket through said open side, said open side of said pocket being positioned in spaced relationship from an edge of said flexible band to inhibit access to said pocket when said flexible band is being worn by the user, said pocket being visually obscured by said flexible band". The Tomlinson reference teaches a personal and easily-accessible carrier for a condom that fails to teach pocket being positioned on an interior surface of the flexible to receive the a user accessory with the open side of the pocket being positioned in a spaced relationship to the edge of the flexible band as claimed by the applicant. Further, the Tomlinson reference teaches the primary cloth pocket being positioned adjacent an edge of the carrier to allow ready accessibility of the condom in the secondary pocket that is placed inside the primary cloth pocket and therefore the Tomlinson reference fails to meet the requirements of the applicant's claims. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaa Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is

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contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Tomlinson reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 2, 3, 5, 7 and 8 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 3, 5, 7 and 8 are also believed to be allowable over the cited reference.

Claims 12 and 14 are dependent upon claim 11, particularly as amended, and therefore incorporates the requirements of claim 11. Thus, claims 12 and 14 are also believed to be allowable over the cited reference.

Claims 4 and 9 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1-5, 7-9, 11, 12 and 14 is therefore respectfully requested.

Paragraphs 12 through 15 of the Office Action

Claims 3, 5, 10, 12 and 16 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Smart (US 4,825,475) in view of Tomlinson (US 5,794,769).

Claims 6, 10, 13, 15 and 16 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Tomlinson (US 5,794,769) in view of Smart (US 4,825,475).

In regard to claims 1 and 11, it is submitted that the combination of Smart with Tomlinson, or vice versa, is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the

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references do not disclose, teach or suggest "a pocket positioned on an interior surface of said flexible band, said pocket selectively retaining a user accessory, said pocket having an open side for permitting insertion of the user accessory in said pocket through said open side, said open side of said pocket being positioned in spaced relationship from an edge of said flexible band to inhibit access to said pocket when said flexible band is being worn by the user, said pocket being visually obscured by said flexible band". As discussed above, the Smart and Tomlinson references fail to teach pocket being positioned on an interior surface of the flexible to receive the a user accessory with the open side of the pocket being positioned in a spaced relationship to the edge of the flexible band as claimed by the applicant. Further, the Smart reference teaches away from a combination with the Tomlinson reference in that the Smart reference requires the clip to being inserted into the pocket to secure the band to the article of clothing whereas to insert the clip into the pocket of the Tomlinson reference may possible compromise the condom within the pocket and therefore reduce the chances that the condom will function properly and therefore defeat the purpose of the Tomlinson reference to encourage safe intercourse. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to

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change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)

(emphasis in original).

Therefore, it is submitted that the combination of the Smart reference with the Tomlinson reference, or vice versa, would not lead one to the combination of features as claimed by the applicant.

Claims 3, 5, 6 and 10 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 3, 5, 6 and 10 are also believed to be allowable over the cited reference.

Claims 12, 15 and 16 are dependent upon claim 11, particularly as amended, and therefore incorporates the requirements of claim 11. Thus, claims 12, 15 and 16 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 3, 5, 10, 12 and 16 is therefore respectfully requested.

Withdrawal of the §103(a) rejection of claims 6, 10, 13, 15 and 16 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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